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REMARKS/ARGUMENTS

Claims 1 through 12 and 14 through 21 are pending. Claims 1 through 12 and 14 through 21 are rejected. The Specification is objected to because of informalities. Claims 1 and 9 are objected to because of informalities. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 9-12, 14, 15, and 21 are rejected under 35 U.S.C. 102(a) as being anticipated by prior art. Claims 1-3, 6-8, 16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,801,341 to Joffe, et al. (hereinafter "Joffe") in view of U.S. Patent 6,330,070 to Toyoda, et al. (hereinafter "Toyoda"). Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Joffe and Toyoda as applied to claim 1, and further in view of U.S. Patent 6,825,955 to Shibata, et al. (hereinafter "Shibata"). Claims 5 and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Joffe, Toyoda and Rabenko.

These objections are respectfully traversed.

Specification Informalities

The informalities noted by the Examiner have been addressed. Withdrawal of the objection is requested.

Claims Informalities

Amendments have been made to address the noted informalities. Withdrawal of the objection is requested.

35 U.S.C. 112 Rejections

The Examiner improperly asserts that the limitation "a first Internet service provider that is not a fax gateway" is not supported or described in the original specification filed on September 29, 2000. In fact, the specification clearly discloses in Fig.1 that the prior art Internet Service Providers 130 and 135 each have Fax Over IP Protocol 132 and 137, respectively, and T38 Protocol 134 and 139, respectively. Fig. 2 the discloses an Internet Service Provider 230 without a Fax Over IP Protocol or T38 Protocol – clearly, one skilled in the relevant art would

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ascertain that Internet Service Provider 230 does not have a Fax Over IP Protocol or T38 Protocol, as such is not disclosed in the drawings or described in the specification. This is also explicitly stated at page 9, lines 3-4: "Given that the fax over Internet protocol is supported by the client 250 itself, the client 250 need not rely on an ISP to support a fax over Internet protocol session." There is no requirement that the applicant is limited to the nomenclature in the specification, see M.P.E.P. 608.01(o). "Amendments to an application which are supported in the original description are NOT new matter. Mere rephrasing of a passage does not constitute new matter" M.P.E.P. 2163.07. The limitation of "a first Internet service provider that is not a fax gateway" is a mere rephrasing of what is disclosed in the drawings and the specifications. The rejection of claim 9 under 35 U.S.C. 112 for the reasons asserted by the Examiner imposes requirements that are contrary to the express language of the M.P.E.P. and that exceed the statutory mandate of 35 U.S.C. 112. Withdrawal of this rejection is required.

35 U.S.C. 102(a) Rejections

After rejecting claim 9 under 35 U.S.C. 112 as allegedly containing subject matter that is not supported nor described in the original specification, the Examiner then rejects claims 9-12, 14, 15 and 21 as being anticipated by the prior art shown in Figure 1, asserting that Internet Service Provider 130 "is not a fax gateway." This assertion is entirely at odds with the rejection under 35 U.S.C. 112 that the limitation "a first Internet service provider that is not a fax gateway" is not supported or described in the original specification filed on September 29, 2000 – does the application disclose an Internet Service Provider that is not a fax gateway, as asserted by the Examiner in rejecting the claims under 35 U.S.C. 102(a), or does it fail to disclose an Internet Service Provider that is not a fax gateway, as asserted by the Examiner in rejecting the claims under 35 U.S.C. 112? The Examiner simply cannot credibly take both positions.

Clearly, it is the term "fax gateway" that the Examiner is actually objecting to. Again, M.P.E.P. 608.01(o) and 2163.07 make it clear that the Applicant is not limited to the nomenclature in the specification, and that rephrasing of nomenclature in the specification is not new matter. One of ordinary skill in the art would clearly understand from Fig. 1 and Fig.2 that Internet Service Provider 130 must have Fax Over IP Protocol 132 and T38 Protocol 134, and that Internet Service Provider 230 does not. In fact, the terminology for an Internet Service Provider that provides for Fax Over IP Protocol and T38 Protocol as being a "fax gateway" was

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taken from the *very prior art originally cited against the claims by the Examiner!* See Intel White Paper at page 4 of 8. ("In the T.38 architecture, fax signals are demodulated at the voice/fax gateway and sent over the IP network. . . .), The Examiner has thus implicitly conceded that one of ordinary skill in the art would understand that an Internet Service Provider that provides for Fax Over IP Protocol and T38 Protocol is a "fax gateway," and that an Internet Service Provider that lacks such capability would not be a fax gateway. Withdrawal of the rejection of claims 9-12, 14, 15, and 21 is requested.

35 U.S.C. 103(a) Rejections

Joffe in view of Toyoda fails to provide a prima facie basis for the rejection of claims 1-3, 6-8, 16, and 18-20, as they fail to disclose each element of the claimed invention.

Claim 1 includes "a client having a T38 protocol client driver that is operable to support a fax over Internet protocol session." Claim 16 includes "connecting a client to a first Internet service provider that does not need to include fax over IP protocol functionality over a first connection, the client comprises a fax over Internet protocol client driver that is operable to support a fax over Internet protocol session." As admitted by the Office, Joffe fails to disclose that a T.38 protocol driver is included in the client system. Contrary to the assertion that Toyoda discloses a client having a T.38 protocol driver that "directly transmits the facsimile data via the Internet," Toyoda in fact fails to disclose T.38 at all! Instead, it discloses at col. 2, lines 49-64 that "FIG. 1 shows a network configuration diagram of the relay system using the Internet facsimile in the present embodiment as a relay apparatus. In FIG. 1, Internet facsimile 11 or personal computer 12 functions as a requesting terminal that uses Internet facsimile 14 as a relay apparatus and facsimile 15 functions as a destination terminal that receives data replayed by Internet facsimile 14. *The data sent by E-mail from the requesting terminal* (Internet facsimile 11 or personal computer 12) is stored in mail server 13 via the Internet. *Internet facsimile 14 converts the E-mail collected from mail server 13 to data in a facsimile data format* and transfers it to the destination terminal (facsimile 15) via a telephone line network (PSTN: Public Switched Telephone Network) according to a facsimile procedure." (Emphasis added). Thus, unlike the T.38 protocol, which does not require an intermediate protocol format such as e-mail for transmission across the Internet, Toyoda is incapable of direct transmission of facsimile data

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from a client over the Internet. Consider the typical example where a user at home does not connect to the Internet via a LAN and thus does not have an email server associated with their terminal. Toyoda, in addition to entirely failing to disclose T.38, would entirely fail to allow "connecting a client to a first Internet service provider that does not need to include fax over IP protocol functionality over a first connection, the client comprises a fax over Internet protocol client driver that is operable to support a fax over Internet protocol session," and would instead require a local area network and mail server to be connected between the client and the Internet service provider. Furthermore, the sending of email is not "a fax over Internet protocol session." Referring to the OSI model, the Simple Mail Transfer Protocol or SMTP operates on top of the TCP/IP protocol, whereas T.38 allows facsimile transmissions to occur using only the TCP/IP protocol. In essence, Toyoda teaches a system for converting faxes into emails, not for fax over IP protocol. A client comprising a fax over Internet protocol client driver that is operable to support a fax over Internet protocol session in accordance with the teachings of Toyoda would also need to be operable to support email communications over an Internet protocol session, which would require an SMTP-compatible system or other suitable functionality. Such functionality is not required by claims 1 and 16.

An example of the mis-application of Toyoda is reflected in the rejection of claims 6, where the Office states that "each time the facsimile data is transmitted to the Fax 15 or the other facsimile machines, another Internet protocol session over the connection with the first Internet service provider is performed." However, mail applications frequently transmit mail between two locations sharing the same IP address in a single Internet protocol session, and in fact, may persistently maintain the same port for such communications in many cases, such as where the mail servers are on different LANs for an organization that communication mail between the LANs over the Internet. The requirement of Toyoda for an email server to allow the client to communicate facsimile data over the Internet leads to the inescapable conclusion that Toyoda fails to disclose a client having a T38 protocol client driver that is operable to support a fax over Internet protocol session or connecting a client to a first Internet service provider that does not need to include fax over IP protocol functionality over a first connection, the client comprises a fax over Internet protocol client driver that is operable to support a fax over Internet protocol session.

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Claims 2 through 8 and claims depend from claim 1, and claims 17 through 20 depend from claim 16, and each are allowable at least for the reasons that they depend from an allowable base claim and add limitations not found in the prior art. The Applicant reserves the right to specifically traverse the rejection of these claims upon appeal in the event this rejection is made final.

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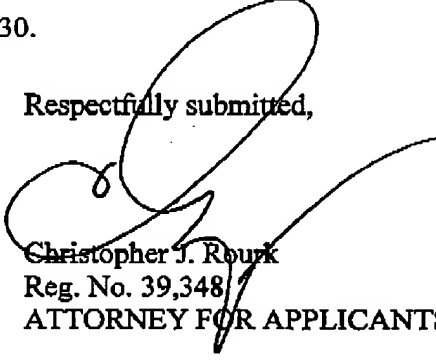
CONCLUSION

In view of the foregoing remarks and for various other reasons readily apparent, Applicants submit that all of the claims now present are allowable, and withdrawal of the rejection and a Notice of Allowance are courteously solicited.

If any impediment to the allowance of the claims remains after consideration of this amendment, a telephone interview with the Examiner is hereby requested by the undersigned at (214) 939-8657 so that such issues may be resolved as expeditiously as possible.

No fee is believed to be due at this time. If any applicable fee or refund has been overlooked, the Commissioner is hereby authorized to charge any fee or credit any refund to the deposit account of Godwin Gruber LLP, No. 500530.

Respectfully submitted,


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